



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/861,231	05/21/97	ILVESPA A	H 1781-73

QM61/0308  
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EXAMINER

WILSON, F

ART UNIT PAPER NUMBER

3744

DATE MAILED: 03/08/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Office Action Summary**

Application No.

**08/861,231**

Applicant(s)

**Hvespaa**

Examiner

**Pamela A. Wilson**

Group Art Unit

**3744**



☒ Responsive to communication(s) filed on 11/6/98 and 12/28/98

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

**Disposition of Claims**

☒ Claim(s) 1-26, 28-34, and 36-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-25 is/are allowed.

☒ Claim(s) 26, 28-34, and 36-41 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

**Application Papers**

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **SUPPLEMENTAL OFFICE ACTION**

This is a Supplemental Office Action to the Office Action mailed on February 17, 1999. The changes which have been implemented into this Supplemental Office Action pertain *only* to the claim numbers which are rejected under 35 U.S.C. 112, first paragraph and 35 U.S.C. 351.

#### ***Specification Objection***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.
- (b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.
- (c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it:

The specification is objected to under 37 CFR 1.71 because it fails to provide a sufficient and proper disclosure for the claim language of moisturizing a paper web through the means and the method of the application moisture .

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***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 26, 28-34 and 36-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the original patent specification, upon which the present reissue is based, in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. *Gentry Gallery, Inc. v. Berkline Corp.* (Fed. Cir. January 1988), and *Tronzo v. Biomet, Inc.*, USPQ2d 1829 (Fed. Cir. August 28, 1998).

The invention of the original patent comprises at least one steam box for applying *steam* onto the entire width of a paper web in the drying section of a paper machine. However, the aforementioned claims disclose a means and method for applying *moisture* onto the paper web. The original patent is clearly limited to the introduction of moisture into a paper web through the means of applying *steam*.

***Recapture Rejection***

Claims 26, 28-34 and 36-41 are rejected under 35 U.S.C. 351 as being an improper recapture of claimed subject matter which broadens the scope of the claims of the original patent

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upon which the present reissue is based. As stated in *In re Clement*, 45 USPQ2d 1161 (Fed. Cir. 1997).

Claims 26, 28-34 and 36-41 do not contain specific claim limitations which were amended into the claim language, of the original patent, in an effort to define the applicant's invention over the prior art; and thus, the lack of this amended claim language is considered to violate the doctrine of recapture. The following claim language, from the original patent, is believed to be absent from the newly submitted claims of the present reissue:

The application of a steam treatment to an open face of a paper web, during the run of the web through the drying section of the paper machine; wherein, the web has opposed top and bottom sides and by pressing the bottom side of the web against the drying cylinders as the web runs on a wire (or a free draw), after the bottom side of the web separates from the heated face of the drying cylinders, the temperature of the bottom side of the web is raised by applying a sufficient amount of steam onto the bottom side of the web for the purpose of controlling the moisture gradient in the thickness direction of the paper web between the paper sides.

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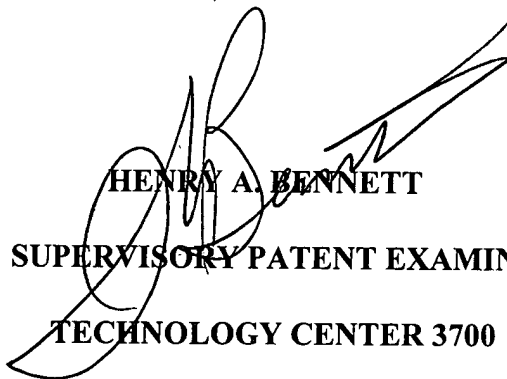
*Allowable Subject Matter*

Claims 1-25 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pamela Wilson whose telephone number is: 703/308-2620. Information may also be sent to the attention of the examiner via facsimile machine at: 703/308-7764.

Pamela Wilson: paw

February 24, 1999



**HENRY A. BENNETT**  
**SUPERVISORY PATENT EXAMINER**  
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